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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,246	10/02/2003	John C. Reed	66821-235	8403

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EXAMINER

CARLSON, KAREN C

ART UNIT PAPER NUMBER

1653

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,246

Applicant(s)

REED ET AL.

Examiner

Karen Cochran Carlson, Ph.D.

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 24, 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 11-25 and 27-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1653

Applicant's election with traverse of Group 36, Claim 26 as drawn to SEQ ID NO: 1 in the reply filed on February 24, 2005 is acknowledged. The traversal is on the ground(s) that the oligonucleotides of Claim 9 (Group 8, drawn to antisense oligonucleotides, Claims 9-12, 22, and 28) is used in the method of Claim 26 and therefore a search of the method of Claim 29 would necessarily encompass the search of Claim 9. Additionally, Groups 37-42 should also be searched because they are all directed to Claim 26, and a search of Claim 26 would likely reveal art on these other Groups 37-42.

Applicants points have been well-taken. Claims 9 and 10 as these claims are drawn to SEQ ID NO: 1 have been rejoined with Group 36. The remaining Claims of Group 8 are drawn to antisense nucleic acids, which have a function of preventing translation as noted on page 31 of the specification. The Examiner did not examine Claim 9 with reference to the oligonucleotides being antisense oligonucleotides, which is not required in the elected method of Group 36.

Regarding Groups 37-42, only SEQ ID NO: 1 and the encoded polypeptide of SEQ ID NO: 2 were searched by the Examiner. The Examiner is unaware that any art was found that would disclose an oligonucleotide that would identify members of the SMDP and/or SCP, except Siah-1 α , as defined on page 12 of the specification.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-46 are pending. Claims 1-8, 11-25, and 27-46 have been withdrawn from further consideration by the Examiner because these claims are drawn to non-elected inventions. Claims 9, 10, and 26, as these claims are drawn to SEQ ID NO: 1, are currently under examination.

Priority is set to June 11, 1999.

The disclosure is objected to because of the following informalities:

Art Unit: 1653

At page 1, line 4, after "2000," insert — now U.S. Patent 6,638,734, —.

At page 7, line 13, replace "Figure13 shows" with — Figures 13A-13C show —.

At page 9, line 4, replace "Figure 17 shows" with —Figures 17A and 17B show —.

Appropriate correction is required.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

At page 23, line21, please delete "http://".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 10, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 9, it is not clear what is meant by "specifically hybridizing", or what conditions would result in specific hybridization of nucleic acid to SEQ ID NO: 1.

The acronyms "SMDP and/or SCP" should be spelled out in Claim 26.

The specification (page 12) defines "SMDP and/or SCP" as being exemplified by Siah-1 α SIP-L, SIP-S, SAF-1 α , SAF-1 β , SAF-2, and SAD. Elected SEQ ID NO: 1 encodes Siah-1 α and would not be expected to identify other proteins. Therefore, in Claim 26, the term "SMDP and/or SCP" should be amended to recite — Siah-1 α — .

Claim 26 is indefinite because the claim does not identify the hybridizing nucleic acid as encoding a Siah-1 α protein. Also, the hybridization conditions are not set forth, and therefore

Art Unit: 1653

one skilled in the art cannot know the metes and bounds of the nucleic acids expected to hybridize to SEQ ID NO: 1.

The Claims recite non-elected subject matter. Therefore, the Claims do not particularly point out and distinctly claim the subject matter which the applicant regards as his elected invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 9 is rejected under 35 U.S.C. 102(a) as being anticipated by Volario et al. (1998; DNA Seq. 9 (5-6): 307-315).

Volario et al. teach a nucleic acid sequence that is identical to nucleotides 213-1274 of instant SEQ ID NO: 1. Therefore, Volario et al. teach an oligonucleotide comprising at least 15 nucleotides capable of specifically hybridizing to SEQ ID NO: 1.

Claim 9 is rejected under 35 U.S.C. 102(a) as being anticipated by Telerman et al. (USP 6,503,203).

Telerman et al. teaches their SEQ ID NO: 11 which is 99.7% identity with nucleotides 322-1274 of instant SEQ ID NO: 1. Therefore, Telerman et al. teach an oligonucleotide comprising at least 15 nucleotides capable of specifically hybridizing to SEQ ID NO: 1.

Art Unit: 1653

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946.

The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Karen Cochrane Carlson, Ph.D." with a stylized flourish at the end.

**KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER**